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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q55501

Erich GUENTHER

Appln. No.: 09/520,890

Group Art Unit: 2174

Confirmation No.: 9865

Examiner: Mylinh T. TRAN

Filed: March 7, 2000

For: PAGE WINDOWS FOR COMPUTER-CONTROLLED PROCESS AND METHOD FOR
CREATING PAGE WINDOWS

**PETITION TO WITHDRAW FINALITY
UNDER 37 C.F.R. § 1.181**

ATTN: Technology Director
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

JUN 18 2004

Technology Center 2100

Sir:

Applicant submits that the Final Office Action dated May 20, 2004, improperly has been made final and thus respectfully solicits withdrawal of the finality of the Office Action.

Specifically, the Examiner sets forth at least one new ground of rejection that was not necessitated by Applicant's amendments.

With respect to claims 13, 15, 16, 19, 20, 22, 25, 26 and 28, these claims presently stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,731,302 to Cote *et al.* Previously, claims 13, 15, 16, 19, 20, 25, 26 and 28 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,480,201 to Fushiki *et al.* and claim 22 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,256,625 to Breyer *et al.* in view of Fushiki. Applicant successfully traversed the rejections of

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claims 13, 15, 16, 19, 20, 22, 25, 26 and 28 with a Rule 131 Declaration, effectively removing Fushiki *et al.* as a reference.

In the February 26, 2004 Rule 111 Amendment, claims 13, 15, 16, 19, 20, 22, 25, 26 and 28 were editorially amended as follows:

Claim 13: the reference characters “(a)”, “(b)”, “(c)” and “(d)” were deleted.

Claims 15, 16: the phrase “step (b)” was deleted and the phrase “retrieving a secondary image” was inserted. Claims 15 and 16 depend from claim 13, and since the “(b)” reference in line 5 of claim 13 (*i.e.*, “retrieving a secondary image...”) was deleted, claims 15 and 16 were editorially amended to reflect the changes in claim 13.

Claim 19, 20: the phrase “step (c)” was deleted and the phrase “merging the retrieved base and secondary images” was inserted. Claims 19 and 20 depend from claim 13, and since the “(c)” reference in line 7 of claim 13 (*i.e.*, “merging the retrieved base image with the retrieved secondary image...”) was deleted, claims 19 and 20 were editorially amended to reflect the changes in claim 13.

Claim 22: the reference characters “(a)”, “(b)”, “(c)” and “(d)” were deleted.

Claim 25: the phrase “step (c)” was deleted and the phrase “merging the retrieved base and secondary images” was inserted. Claims 25 and 26 depend from claim 22, and since the “(c)” reference in line 10 of claim 13 (*i.e.*, “merging the retrieved base image with the retrieved secondary image...”) was deleted, claims 25 and 26 were editorially amended to reflect the changes in claim 22.

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Claim 28: the reference characters “(a)”, “(b)”, “(c)” and “(d)” were deleted.

While it is true that amendments were made to claims 13, 15, 16, 19, 20, 22, 25, 26 and 28, Applicant submits that these amendments did not necessitate the new basis of rejection. This is especially true for the amendments made to claims 13, 22 and 28. The amendments made to claims 13, 15, 16, 19, 20, 22, 25, 26 and 28 consist *solely* of editorial amendments. This cannot constitute a basis for citing new art, nor can one find a single new recitation in the claims that the new art is relied upon to teach.

Despite this, the Examiner issued a Final Office Action, dated May 20, 2004, in which the Examiner propounded a new rejection against claims 13, 15, 16, 19, 20, 22, 25, 26 and 28. In the Final Office Action at page 6, the Examiner stated that the rejection was a new one. A reading of the rejection shows that the Examiner cited Cote *et al.* as “teaching retrieved images composed of at least one base image and secondary element from storage ... and merging the retrieved based image with the retrieved secondary image to form a page window....” For the first time in the Final Office Action dated May 20, 2004, the Examiner cited Cote *et al.* as allegedly teaching the particular features of the invention as recited in claims 13, 15, 16, 19, 20, 22, 25, 26 and 28. Yet, this new rejection is clearly directed to features that existed in the claims as originally filed, as discussed above. Thus, Applicant’s amendments could not have necessitated this new ground of rejection.

With respect to claims 1-12, 14, 17, 18, 21, 23, 24, 27 and 29-37, these claims presently stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No.

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4,942,515 to Miyagaki *et al.* in view of U.S. Patent No. 6,731,302 to Cote *et al.* Previously, claims 1-12, 14, 17, 18, 21, 23, 24, 27 and 29-37 rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,256,625 to Breyer *et al.* in view of Fushiki. Applicant successfully traversed the rejections of claims 1-12, 14, 17, 18, 21, 23, 24, 27 and 29-37 with a Rule 131 Declaration, effectively removing Fushiki as a reference.

Although Miyagaki *et al.* was submitted by the March 25, 2003 Information Disclosure Statement, MPEP § 706.07(a) states that a final rejection is improper when new ground of rejection ***that was not necessitated by amendment*** to the claims is introduced by the Examiner. As discussed below, a new ground of rejection was introduced by the Examiner on claims that were either editorially amended, or not amended at all.

In the February 26, 2004 Rule 111 Amendment, claims 1-12 ***were not amended*** and claims 14, 17, 18, 21, 23, 24, 27 and 29-37 were editorially amended as follows:

Claims 14, 17, 21: the phrase “step (a)” was deleted and the phrase “retrieving a base image” was inserted. Claims 14, 17 and 21 depend from claim 13, and since the “(a)” reference in line 3 of claim 13 (*i.e.*, “retrieving a base image...”) was deleted, claims 14, 17 and 21 were editorially amended to reflect the changes in claim 13.

Claim 23, 27: the phrase “step (a)” was deleted and the phrase “retrieving a base image” was inserted. Claims 23 and 27 depend from claim 22, and since the “(a)” reference in line 6 of claim 22 (*i.e.*, “retrieving a base image...”) was deleted, claims 23 and 27 were editorially amended to reflect the changes in claim 22.

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Claim 24: the phrase “step (b)” was deleted and the phrase “retrieving a secondary image” was inserted. Claim 24 depends from claim 22, and since the “(b)” reference in line 8 of claim 22 (*i.e.*, “retrieving a secondary image...”) was deleted, claim 24 was editorially amended to reflect the changes in claim 22.

Claim 29: the reference characters “(a)”, “(b)”, “(c)” and “(d)” were deleted.

Claims 30, 31: the phrase “step (c)” was deleted and the phrase “merging the retrieved base and secondary images” was inserted. Claims 30 and 31 depend from claim 29, and since the “(c)” reference in line 7 of claim 29 (*i.e.*, “merging the retrieved base image with the retrieved secondary image...”) was deleted, claims 30 and 31 were editorially amended to reflect the changes in claim 29.

Claim 32: the phrase “step (a)” was deleted and the phrase “retrieving a base image” was inserted. Claim 32 depends from claim 29, and since the “(a)” reference in line 3 of claim 29 (*i.e.*, “retrieving a base image...”) was deleted, claim 32 was editorially amended to reflect the changes in claim 29.

Claim 33: the reference characters “(a)”, “(b)”, “(c)” and “(d)” were deleted.

Claims 34, 35: the phrase “step (c)” was deleted and the phrase “merging the retrieved base and secondary images” was inserted. Claims 34 and 35 depend from claim 33, and since the “(c)” reference in line 9 of claim 33 (*i.e.*, “merging the retrieved base image with the retrieved secondary image...”) was deleted, claims 34 and 35 were editorially amended to reflect the changes in claim 33.

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Claim 36: the phrase “step (a)” was deleted and the phrase “retrieving a base image” was inserted. Claim 36 depends from claim 33, and since the “(a)” reference in line 6 of claim 33 (*i.e.*, “retrieving a base image...”) was deleted, claim 36 was editorially amended to reflect the changes in claim 33.

Claim 37: the reference characters “(a)”, “(b)”, “(c)” and “(d)” were deleted.

While it is true that amendments were made to claims 14, 17, 18, 21, 23, 24, 27 and 29-37, Applicant submits that these amendments did not necessitate the new basis of rejection. This is especially true for the amendments made to claims 29, 22 and 37. The amendments made to claims 14, 17, 18, 21, 23, 24, 27 and 29-37 consist *solely* of editorial amendments. Critically, claims 1-12 were not amended at all, but the Examiner maintains that Applicant’s amendments necessitated a new ground of rejection. This cannot constitute a basis for citing new art, nor can one find a single new recitation in the claims that the new art is relied upon to teach. For the first time in the Final Office Action dated May 20, 2004, the Examiner cited Cote *et al.* as allegedly teaching the particular features of the invention recited in claims 1-12, 14, 17, 18, 21, 23, 24, 27 and 29-37. Yet, this new rejection is clearly directed to features that existed in the claims as originally filed, as discussed above. Thus, Applicant’s amendments could not have necessitated this new ground of rejection.

In a telephone conversation with the Examiner, conducted on June 8, 2004, Applicant requested that the Examiner reconsider the finality of the outstanding Office Action. The Examiner attempted to contact Applicant’s undersigned representative and requested that the

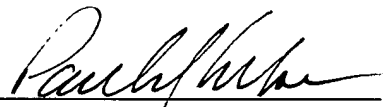
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instant Petition be filed. In response, Applicant submits this petition. The information and arguments presented above duplicate the substance of the interview and constitute a summary thereof.

For the reasons discussed above, Applicant requests that the finality of the May 20, 2004 Office Action be withdrawn.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,


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CUSTOMER NUMBER

Date: June 15, 2004